

Remarks

The Applicant appreciates the Examiner's continued consideration of the present Application, and especially appreciates the Examiner's time during the Examiner's Interview conducted on December 20, 2005. It was the Applicant's understanding that the Examiner would provide an Interview Summary, and so the Applicant has not provided any such summary herewith or otherwise.

In the non-final Office action mailed on August 1, 2005, claims 24-42 were objected to because of various informalities. Also, claim 34 (pertaining to real property) was rejected under 35 U.S.C. 112. Further, each of claims 24, 25, 27, 32, 33, 35-38 and 42 was rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (U.S. Patent No. 5,892,900). Additionally, claims 26 and 43 were rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al., claim 34 was rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ginter et al. and Ashenmil (U.S. Patent No. 6,615,187), and claims 28-31 and 39-41 were rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Ginter et al. and plx (The Patent and License Exchange FAQ sheet, copyright 1999).

In view of the Office action and especially in view of the Examiner's Interview, the Applicant has amended all of the pending claims 24-43, with claim 42 now depending from amended independent claim 43. As discussed in more detail below, each of the independent claims 24, 35 and 43 has in particular been amended to include one or more new features, and the Applicant also has amended many of the dependent claims to recite additional and/or new features. Many of these amendments are being made in direct response to the comments of the Examiner during the Examiner's Interview.

The Applicant respectfully submits that the claim amendments do not add new matter to the Application and are supported by the Specification. The Applicant further submits that, in view of these amendments and as discussed in more detail below, all of the pending claims 24-43 are now allowable under 35 U.S.C. 102 and 103(a).

With respect to claim 34 relating to real property, the Applicant has entirely eliminated any reference to real property in this or any of the other claims. Although the Applicant has eliminated any claim relating to real property, the Applicant's decision to

do so should not be considered as an admission by the Applicant as to the propriety of any of the rejections relating to the recitation of real property (e.g., under 35 U.S.C. 112 or 103(a)). Rather, the Applicant has removed the reference to real property in the claims merely to improve the focus of the present Applicant, and without prejudice to the pursuit of any future claims relating to real property in any future or other related patent applications (e.g., continuations and/or continuations-in-part). In any event, in view of this amendment to claim 34, the Applicant submits that claim 34 is allowable under 35 U.S.C. 112.

Further in view of these amendments, the Applicant submits that the grounds for the objections to the claims appear to be moot with the exception of the objection regarding the use of the term "automatic" (which is still employed in amended claims 27 and 40), the use of the term "interest" and the use of the term "exchange". The Applicant addresses how the Applicant believes these terms should be construed below, and submits that the claims no longer suffer from informalities as indicated in the Office action.

Therefore, in view of the amendments to the claims, and as discussed in more detail below, the Applicant submits that all of the rejections of and objections to the claims have been overcome, and that the Application is now in condition for allowance.

Amendments to Independent Claim 24 and Resulting Allowability of Claims 24-34

Independent claim 24 has been amended in a number of ways. First, claim 24 has been amended to pertain to an intellectual property asset rather than to any property asset. Further, claim 24 has been amended so as to recite a method of transferring intellectual property that requires that two different types of information be provided in two steps of operation--namely, information of a first type relating to a nature of an intellectual property asset and information of a second type relating to an extent of an interest in the intellectual property asset that is about to be transferred. Additionally, claim 24 has been amended to clarify that, in these embodiment of the invention, the information of the first type is utilized (as recited in a new step (b)) to make a determination concerning the availability or desirability of the intellectual property asset based upon the received information of the first type.

Also, claim 24 has been amended to clarify that the “first party” performing the method of claim 24 can be either the recipient or the source of the intellectual property asset being transferred in any given transaction. Additionally, claim 24 has been amended to further clarify that the method is an internet-based method of transfer, e.g., multiple types of information are received by the first party off of the internet in steps (a) and (c).

In view of these amendments to claim 24, the Applicant respectfully submits that claim 24 and claims 25-34 depending therefrom are allowable over Ginter et al. under 35 U.S.C. 102 and/or 35 U.S.C. 103(a). As was briefly discussed in the Examiner’s Interview, the Applicant is unable to find within Ginter et al. any discussion of a multi-step, internet-based method relating to intellectual property transfer in which two different types of information are received by a computer of one party from another party (or system associated with another party) via the internet. Further, the Applicant is unable to find within Ginter et al. any discussion of such a multi-step, internet-based method that further includes a step in which the received information of the first type is employed to make a determination regarding the availability or desirability of the intellectual property asset. In particular, the Applicant is unable to find such discussion within columns 269-272 of Ginter et al.

Further, the Applicant respectfully submits that it would not have been obvious to provide such a method in view of Ginter et al. As discussed at pages 25-26 of the Specification of the present Application, the Applicant’s multi-step method is advantageous insofar as it allows a preliminary determination to be made regarding the intrinsic value of the particular intellectual property asset that is at issue, prior to addressing other more specific issues regarding the transfer of intellectual property, such as those relating to the exact extent of the interest in the intellectual property asset that is going to be transferred or other contractual details (e.g., price). In contrast, the Applicant is unable to find any discussion of such advantages or purposes (or the desirability of such advantages or purposes) in Ginter et al. For at least this reason, the Applicant respectfully submits that it would not have been obvious to one of ordinary skill in the art to arrive at the Applicant’s claim 24 invention in view of Ginter et al.

For at least these reasons, therefore, the Applicant submits that claims 24-34 are allowable under 35 U.S.C. 102 and 35 U.S.C. 103(a) in view of Ginter et al., and requests allowance of these claims.

Additional Amendments to Dependent Claims 25-34 & Reasons for Allowability Thereof

The Applicant has also amended each of the claims depending from independent claim 24, namely, claims 25-34, as shown above. In particular, claim 25 has been amended to specify in more detail several of the operations that can be performed by the computer in step (b) of claim 24. These operations find support in the Specification at various places including in FIGS. 5A-5C. Claim 26 additionally has been amended to specify that step (b) of claim 24 includes two or more of the operations specified in claim 25, while claim 27 additionally has been amended to specify that step (c) of claim 24 includes three or more of the operations specified in claim 25. Claim 28 further has been amended to specify that the intellectual property asset of claim 24 is a patent, while claims 29 and 30 have respectively been amended to further specify additional information that can be provided in steps (a) and (c) of claim 24, respectively.

Additionally, claim 31 has been amended to require that additional information be received off of the internet relating to the identity of the second party, and thus further emphasizes that the claimed invention is for an internet-based method. Claim 32 has been amended to conform that claim to amended claim 24 regarding an intellectual property asset, and claim 34 has been amended to further specify the type of intellectual property asset (as indicated above, amended claim 34 no longer recites real property). Finally, claim 33 has been further amended to conform to claim 24. More specifically, since claim 24 now has been amended to encompass both situations in which the first party is the source or the recipient of the intellectual property asset, claim 33 identifies the steps of claim 24 as pertaining to the transfer of the intellectual property asset from the first party to the second party, and then further introduces additional steps pertaining to an additional transfer from a third party to the first party.

In particular with respect to amended claims 25-30, the Applicant respectfully submits that each of these claims is allowable under 35 U.S.C. 102 and 103(a) in view of Ginter et al. for one or more reasons in addition to those identified above in connection

with independent claim 24. In particular, the Applicant is unable to find within Ginter et al. any disclosure or suggestion of any of the operations required by claim 25, much less combinations of those operations as required by claims 26-27, or the combination of one or more of those operations when performed in response to the receiving of first information as recited in step (a) of claim 24. Also, as discussed in further detail below with reference to claims 35-41, Ginter et al. (as stipulated by in the Office action) fails to disclose or suggest the transfer of an intellectual property asset that is a patent asset, and consequently fails to disclose or suggest the transfer of a patent asset as required by claim 28. Additionally, as discussed in further detail below, the Applicant is unable to find any disclosure or suggestion within Ginter et al. regarding the receiving of patent-related information as recited in claims 29 and 30.

For at least these additional reasons, therefore, the Applicant respectfully submits that dependent claims 25-30 are allowable under 35 U.S.C. 102 and 103(a) in view of Ginter et al.

Amendments to Independent Claim 35 and Resulting Allowability of Claims 35-41

Further as shown above, the Applicant has amended independent claim 35 to now be more similar to claim 24 in terms of requiring the receipt of two types of information, and to be applicable to transactions in which the first party is either a source or a recipient of an intellectual property asset. In contrast to claim 24, and largely in response to the discussion in the Examiner's Interview, the Applicant has further amended claim 35 to specify that the intellectual property asset being transferred is a patent asset, and additionally specified in more detail multiple types of patent-related information one or more of which are received as the "first information".

In view of these amendments, the Applicant respectfully submits that claims 35-41 are allowable under 35 U.S.C. 102 in view of Ginter et al., as well as under 35 U.S.C. 103(a) in view of Ginter et al. alone or in combination with plx. To begin with, in the Office action, the Examiner stipulates that Ginter et al. fails to disclose the transfer of a patent (or, presumably, a "patent asset" as required by claim 35). Further, the Applicant is unable to find any disclosure within Ginter et al. regarding receiving any of the various types of "first information" identified in claim 35.

Further, the Applicant respectfully submits that Ginter et al. entirely lacks any suggestion to modify Ginter et al., or to combine Ginter et al. with plx, to arrive at these features. Ginter et al. appears to relate fundamentally to the secure transfer of “electronic content” that is susceptible to unauthorized copying (see, e.g., col. 2, lines 19 et seq.). Because it relates to this type of material, Ginter et al. apparently focuses upon systems that provide for the secure transfer of copyrighted material. In contrast, amended claim 35 specifically relates to the transfer of patent assets rather than copyrights. Unlike copyrightable subject matter such as software and other “electronic content,” the copying of the particular expression within a patent asset does not affect the value of the patent asset, and consequently with respect to the transfer of patents there is no need for a system such as that proposed by Ginter et al. that prevents unauthorized copying.

Because the Applicant’s claim 35 invention does not address the same problems as those addressed by Ginter et al., the Applicant respectfully submits that Ginter et al. lacks any suggestion to modify its teachings to arrive at the Applicant’s claimed invention. Also for this reason, Ginter et al. lacks any suggestion to combine its teachings with those of plx, which relates specifically to patents. Additionally, Ginter et al. and plx are not properly combinable to arrive at the Applicant’s claim 35 invention since (as discussed in detail in the Background of the Invention of the present Application, e.g., at pages 3-4 of the Application) plx concerns an intellectual property exchange, something which the Applicant’s claimed invention is intended to improved upon and does not cover. Further, the Applicant additionally submits that, in any event, the Applicant is unable to find within plx any disclosure of the receipt of any of the types of patent-related information recited in amended claim 35.

For at least these reasons, therefore, the Applicant respectfully submits that independent claim 35 and claims 36-41 depending therefrom are allowable under 35 U.S.C. 102 and 103(a).

Additional Amendments to Dependent Claims 36-41

In addition to the amendments of claim 35, the Applicants have further amended each of dependent claims 36-41. Claim 36 further identifies several types of “patent assets,” and claims 37 and 41 respectively provide further clarification of different types

of first and second information. Claim 38 as amended additionally recites a processing operation performed by the first party computer based upon one or both of the first and second types of information, while claims 39 and 40 further specify that claim 35 concerns a transfer from the first party to a second party and requires that an additional transfer occur from a third party to the first party.

Amendments to Claims 42-43 and Resulting Allowability Thereof

Largely in response to the discussion in the Examiner's Interview, the Applicant has further amended independent claim 43 to recite that the execution of an agreement by the IPIB occurs at least in part based upon information received from a service firm. By virtue of these amendments, claim 43 now makes reference to all 5 actors shown in FIG. 1 of the Application. Additionally, dependent claim 42 has also been amended so as to depend from claim 43 and to further specify that the service firm can in at least some embodiments be a law firm or an accounting firm.

In view of these amendments, the Applicant respectfully submits that claims 42-43 are allowable under 35 U.S.C. 102 and 103(a). In particular, the Applicant has been unable to find disclosure within Ginter et al. or plx of the particular methods recited in claims 42 or 43 involving all of the actors of FIG. 1 of the present Application. Therefore, the Applicant respectfully requests allowance of these claims.

Objections to the Claims

In view of the Amendments to the claims, the Applicant respectfully submits that the objections to the claims are moot or, to the extent that they are not moot, that the claim limitations of interest should be understood as follows (notwithstanding any comment to the contrary in the Office action) and do not suffer from any informalities. To the extent that the Applicant does not in particular address one or more of the informalities noted in the Office action below, the Applicant agrees that the Examiner's construction of the term at issue as set forth in the Office action is acceptable and that such informality is overcome for that reason.

With respect to the term "automatic" used in claims 27 and 40, the Applicant intends such term to be broad and to encompass any operation performed by a computer

or other mechanism. While such operation could include printing, as noted by the Examiner in the Office action, the operation could also encompass a wide variety of other operations including, for example, calculation, processing, sending of communication signals, displaying of information, etc.

With respect to the term "interest" used in several of the pending claims, the Applicant agrees that any transfer of an intellectual property asset will necessarily involve transfer of an interest in such asset. However, the Applicant wishes to stress that, with respect to any given intellectual property asset, it is possible to have a variety of different interests that are transferred. Such interests can include, for example, complete ownership in the entire asset, possession/ownership of a subset of rights or license(s) relating to the asset (e.g., exclusive license, nonexclusive license), etc. (see also, for example, claim 30). For that reason, many of the claims recite not merely the transfer of an asset, but rather recite the transfer of a particular interest in (or particular set of rights pertaining to) the asset.

With respect to the term "exchange", the Applicant intends such term to refer to "markets or forums in which individuals owning intellectual property assets can place those assets up for licensing or sale" and in which "[o]thers interested in licensing or purchasing intellectual property assets can then obtain information regarding, and eventually license or purchase, the intellectual property assets that are available for transfer" (pages 2-3 of the present Application). The Applicant does not intend the term "exchange" to include any party that actually takes an ownership interest in the assets being offered for sale, license or other transfer.

In view of the above discussion, the Applicant respectfully submits that the objections to the claims have been overcome.

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In view of the above Amendments and Remarks, the Applicant respectfully requests reconsideration and allowance of the present Application. In addition to this Amendment, the Applicant is additionally submitting a 2-month extension fee. If further

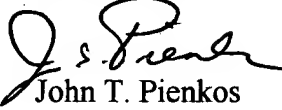
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Amdt. Dated 1/3/06

Reply to Office Action of August 1, 2005

discussion with the Examiner would be helpful, the Applicant requests that the Examiner contact the Applicant by way of telephone at (414) 228-6881.

Respectfully,

A handwritten signature in black ink, appearing to read "John T. Pienkos".

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